

# SOLICITOR

AO 120 (Rev. 2/99)

<b>TO: Mail Stop 8</b> <b>Director of the U.S. Patent &amp; Trademark Office</b> <b>P.O. Box 1450</b> <b>Alexandria, VA 22313-1450</b>	<div style="position: relative; height: 40px;"> <span style="position: absolute; top: -20px; left: 50%; transform: translate(-50%, -50%); font-weight: bold;">JUN 21 2007</span> </div> <div style="text-align: left; margin-top: 10px;"> <b>U.S. PATENT &amp; TRADEMARK OFFICE</b> </div>
<b>REPORT ON THE</b> <b>PROCEEDING OR DETERMINATION OF AN</b> <b>ACTION REGARDING A PATENT OR</b> <b>TRADEMARK</b>	

In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been  
 filed in the U.S. District Court Northern District of California on the following ☒ Patents or ☐ Trademarks:

DOCKET NO. CV 07-03151 WDB	DATE FILED June 14, 2007	U.S. DISTRICT COURT Northern District of California, 1301 Clay St., RM 400S, Oakland, CA 94612
PLAINTIFF RONALD A. KATZ TECHNOLOGY		DEFENDANT ECHOSTAR COMMUNICATIONS CORP, ET.AL

  

PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 <i>19 Pats 195-7</i>		See Attached Complaint
2		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY	
	<input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		See Attached Complaint
2		
3		
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
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CLERK  Richard W. Wieking	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Commissioner    Copy 3—Upon termination of action, mail this copy to Commissioner  
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner    Copy 4—Case file copy

1 E. A judgment holding this Action an exceptional case, and an award to Plaintiff Katz  
2 Technology Licensing for its attorneys' fees and costs pursuant to 35 U.S.C. § 285; and

3 F. Such other relief as the Court deems just and equitable.

4 Dated: June 14, 2007

Respectfully submitted,

By: 

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*Ronald A. Katz Technology Licensing, L.P.*

1 **DEMAND FOR JURY TRIAL**

2 Pursuant to Federal Rule of Civil Procedure 38, Plaintiff Ronald A. Katz Technology  
3 Licensing, L.P. hereby demands trial by jury.

4 Dated: June 14, 2007

Respectfully submitted,

5  
6 By: 

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ORIGINAL  
FILED  
07 JUN 14 PM 3:11  
RICHARD W. WIERING  
U.S. DISTRICT COURT  
NORTHERN DISTRICT OF CALIF.

8  
9 IN THE UNITED STATES DISTRICT COURT  
10 FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

11 RONALD A. KATZ TECHNOLOGY  
12 LICENSING, L.P.,

13 Plaintiff,

14 v.

15 ECHOSTAR COMMUNICATIONS CORP.  
16 and  
ECHOSTAR SATELLITE L.L.C.

17 Defendants.

C07 03151

CASE NO.

WDB

Jury Trial Demanded

18  
19 **PLAINTIFF RONALD A. KATZ TECHNOLOGY LICENSING, L.P.'S**  
20 **COMPLAINT FOR PATENT INFRINGEMENT AND DEMAND FOR JURY TRIAL**

21 Plaintiff, Ronald A. Katz Technology Licensing, L.P. ("Katz Technology Licensing"), by  
22 counsel, alleges as follows:

23 **THE PARTIES**

24 1. Plaintiff Katz Technology Licensing is a limited partnership organized under the  
25 laws of the State of California, and having a principal place of business at 9220 Sunset Blvd.  
26 #315, Los Angeles, CA 90069.

2. On information and belief, Defendant EchoStar Communications Corp. ("ECC") is a Nevada entity maintaining its principal place of business at 9601 South Meridian Boulevard, Englewood, CO 80112.

3. On information and belief, Defendant EchoStar Satellite L.L.C. ("ESLLC") is a Colorado entity maintaining its principal place of business at 9601 South Meridian Boulevard, Englewood, CO 80112.

### JURISDICTION AND VENUE

4. This is a civil action for patent infringement arising under the United States patent statutes, 35 U.S.C. § 1 *et seq.*

5. This Court has jurisdiction over the subject matter of this action under 28 U.S.C. §§ 1331 and 1338(a).

6. Upon information and belief, Defendants ECC and ESLLC (collectively, the “EchoStar defendants”) are subject to this Court’s personal jurisdiction because pursuant to a January 2005 agreement ECC and ESLLC consented to the personal jurisdiction of this Court for suits arising from the Katz Technology Licensing patent portfolio. In addition, the EchoStar defendants do and have done substantial business in this judicial district, including: (i) offering satellite television programming to customers, including customers within this State and in this District; (ii) operating infringing automated telephone call processing systems, including without limitation the DISH Network customer service telephone system, that allow its customers, including customers within this State and in this District, to perform pay-per-view ordering and customer service functions over the telephone; and/or (iii) regularly doing or soliciting business, engaging in other persistent courses of conduct, and/or deriving substantial revenue from services provided to individuals in this State and in this District. In addition, Defendant ESLLC has designated an agent for service of process in the State of California.

7. Venue is proper in this judicial district under 28 U.S.C. §§ 1391(b)-(c) and 1400(b).

## BACKGROUND FACTS

8. Ronald A. Katz ("Mr. Katz"), founder of Katz Technology Licensing, is a named inventor of each of the patents in suit. Mr. Katz has been widely recognized as one of the most prolific and successful inventors of our time, and his inventions over the last forty-plus years have been utilized by literally millions of people.

9. In 1961, Mr. Katz co-founded Telecredit Inc. ("Telecredit"), the first company to provide online, real-time credit authorization, allowing merchants to verify checks over the telephone. Further innovations from Telecredit include the first online, real-time, point-of-sale credit verification terminal, which enabled merchants to verify checks without requiring the assistance of a live operator, and the first device that used and updated magnetically-encoded cards in automated teller machines. Multiple patents issued from these innovations, including patents co-invented by Mr. Katz.

10. Telecredit was eventually acquired by Equifax, and has now been spun off as Certegy, a public company traded on the New York Stock Exchange. Certegy continues to provide services in the credit and check verification field established by Mr. Katz and Telecredit.

11. Mr. Katz's inventions have not been limited to telephonic check verification. Indeed, Mr. Katz is responsible for advancements in many fields of technology. Among his most prominent and well-known innovations are those in the field of interactive call processing. Mr. Katz's inventions in that field are directed to the integration of telephonic systems with computer databases and live operator call centers to provide interactive call processing services.

12. The first of Mr. Katz's interactive call processing patents issued on December 20, 1988. More than fifty U.S. patents have issued to Mr. Katz for his inventions in the interactive call processing field, including each of the patents-in-suit.

13. In 1988, Mr. Katz partnered with American Express to establish FDR Interactive Technologies, later renamed Call Interactive, to provide interactive call processing services based on Mr. Katz's inventions. The American Express business unit involved in this joint venture later became known as First Data.

1           14.     Early clients of Call Interactive included *The New York Times*, ABC's *Monday*  
2 *Night Football*, KABC Radio, CBS News, and Beatrice Foods (Hunt-Wesson division).

3           15.     Many of these clients utilized Call Interactive technology for high-profile events.  
4 For example, CBS News hired Call Interactive to operate an interactive, real-time telephone poll  
5 to gauge viewer reaction to President George H.W. Bush's 1992 State of the Union address.

6           16.     Mr. Katz sold his interest in Call Interactive to American Express in 1989 but  
7 continued to provide advisory services to Call Interactive until 1992. American Express later  
8 spun off the First Data business unit into a separate corporation, and with that new entity went  
9 Mr. Katz's interactive call processing patents and the Call Interactive call processing business.  
10 The former Call Interactive, now known as First Data Voice Services, continues to provide call  
11 processing solutions today.

12           17.     In 1994, Mr. Katz formed Katz Technology Licensing, which acquired the rights  
13 to the entire interactive call processing patent portfolio, including the rights to each of the patents-  
14 in-suit, from First Data, the owner of all of the Katz interactive call processing patents at that  
15 time.

16           18.     The marketplace has clearly recognized the value of Mr. Katz's inventions.  
17 Indeed, over 150 companies have licensed the patents-in-suit. Licensees include IBM, Hewlett-  
18 Packard, Bank of America, JPMorgan Chase, Wells Fargo, HSBC, Verizon, Sprint, Microsoft,  
19 Delta Airlines, Merck, Sears, and Home Shopping Network. These licenses and others  
20 acknowledge the applicability of the patents-in-suit to multiple fields of use, including but not  
21 limited to financial services call processing, automated securities transactions, automated credit  
22 card authorization services, automated wireless telecommunication services and support,  
23 automated health care services, and product and service support.

24           19.     Each of the defendants employs the inventions of certain of the patents-in-suit.  
25 Katz Technology Licensing, through its licensing arm A2D, L.P., has repeatedly attempted to  
26 engage each defendant in licensing negotiations, but to date, none of the defendants have agreed  
27 to take a license to any of the patents-in-suit.

**THE PATENTS-IN-SUIT**

20. On December 20, 1988, the United States Patent and Trademark Office duly and legally issued United States Patent No. 4,792,968 ("the '968 Patent"), entitled "Statistical Analysis System For Use With Public Communication Facility," to Ronald A. Katz, sole inventor. The '968 Patent expired on December 20, 2005.

21. On May 29, 1990, the United States Patent and Trademark Office duly and legally issued United States Patent No. 4,930,150 ("the '150 Patent"), entitled "Telephonic Interface Control System," to Ronald A. Katz, sole inventor. The '150 Patent expired on December 20, 2005.

22. On April 28, 1992, the United States Patent and Trademark Office duly and legally issued United States Patent No. 5,109,404 ("the '404 Patent"), entitled "Telephone Call Processor with Select Call Routing," to Ronald A. Katz and Thomas D. Thompson, co-inventors. The '404 Patent expired on December 20, 2005.

23. On July 7, 1992, the United States Patent and Trademark Office duly and legally issued United States Patent No. 5,128,984 ("the '984 Patent"), entitled "Telephone Interface Call Processing System With Call Selectivity," to Ronald A. Katz, sole inventor.

24. On September 27, 1994, the United States Patent and Trademark Office duly and legally issued United States Patent No. 5,351,285 ("the '285 Patent"), entitled "Multiple Format Telephonic Interface Control System," to Ronald A. Katz, sole inventor. The '285 Patent expired on December 20, 2005.

25. On October 1, 1996, the United States Patent and Trademark Office duly and legally issued United States Patent No. 5,561,707 ("the '707 Patent"), entitled "Telephonic-Interface Statistical Analysis System," to Ronald A. Katz, sole inventor. The '707 Patent expired on December 20, 2005.

26. On November 4, 1997, the United States Patent and Trademark Office duly and legally issued United States Patent No. 5,684,863 ("the '863 Patent"), entitled "Telephonic-Interface Statistical Analysis System," to Ronald A. Katz, sole inventor. The '863 Patent expired on December 20, 2005.



1           27.     On September 29, 1998, the United States Patent and Trademark Office duly and  
2 legally issued United States Patent No. 5,815,551 ("the '551 Patent"), entitled "Telephonic-  
3 Interface Statistical Analysis System," to Ronald A. Katz, sole inventor. The '551 Patent expired  
4 on December 20, 2005.

5           28.     On October 27, 1998, the United States Patent and Trademark Office duly and  
6 legally issued United States Patent No. 5,828,734 ("the '734 Patent"), entitled "Telephone  
7 Interface Call Processing System With Call Selectivity," to Ronald A. Katz, sole inventor.

8           29.     On April 27, 1999, the United States Patent and Trademark Office duly and legally  
9 issued United States Patent No. 5,898,762 ("the '762 Patent"), entitled "Telephonic-Interface  
10 Statistical Analysis System," to Ronald A. Katz, sole inventor. The '762 Patent expired on  
11 December 20, 2005.

12           30.     On June 29, 1999, the United States Patent and Trademark Office duly and legally  
13 issued United States Patent No. 5,917,893 ("the '893 Patent"), entitled "Multiple Format  
14 Telephonic Interface Control System," to Ronald A. Katz, sole inventor. The '893 Patent expired  
15 on December 20, 2005.

16           31.     On October 26, 1999, the United States Patent and Trademark Office duly and  
17 legally issued United States Patent No. 5,974,120 ("the '120 Patent"), entitled "Telephone  
18 Interface Call Processing System With Call Selectivity," to Ronald A. Katz, sole inventor.

19           32.     On November 14, 2000, the United States Patent and Trademark Office duly and  
20 legally issued United States Patent No. 6,148,065 ("the '065 Patent"), entitled "Telephonic-  
21 Interface Statistical Analysis System," to Ronald A. Katz, sole inventor. The '065 Patent expired  
22 on July 10, 2005.

23           33.     On January 1, 2002, the United States Patent and Trademark Office duly and  
24 legally issued United States Patent No. 6,335,965 ("the '965 Patent"), entitled "Voice-Data  
25 Telephonic Interface Control System," to Ronald A. Katz, sole inventor. The '965 Patent expired  
26 on December 20, 2005.

27           34.     On February 19, 2002, the United States Patent and Trademark Office duly and  
28 legally issued United States Patent No. 6,349,134 ("the '134 Patent"), entitled "Telephonic-

Interface Statistical Analysis System,” to Ronald A. Katz, sole inventor. The ‘134 Patent expired on December 20, 2005.

35. On July 23, 2002, the United States Patent and Trademark Office duly and legally issued United States Patent No. 6,424,703 (“the ‘703 Patent”), entitled “Telephone-Interface Lottery System,” to Ronald A. Katz, sole inventor. The ‘703 Patent expired on July 10, 2005.

36. On August 13, 2002, the United States Patent and Trademark Office duly and legally issued United States Patent No. 6,434,223 (“the ‘223 Patent”), entitled “Telephone Interface Call Processing System With Call Selectivity,” to Ronald A. Katz, sole inventor. The ‘223 Patent expired on July 10, 2005.

37. On January 28, 2003, the United States Patent and Trademark Office duly and legally issued United States Patent No. 6,512,415 (“the ‘415 Patent”), entitled “Telephonic-Interface Game Control System,” to Ronald A. Katz, sole inventor. The ‘415 Patent expired on July 10, 2005.

38. On January 13, 2004, the United States Patent and Trademark Office duly and legally issued United States Patent No. 6,678,360 (“the ‘360 Patent”), entitled “Telephonic-Interface Statistical Analysis System,” to Ronald A. Katz, sole inventor. The ‘360 Patent expired on July 10, 2005.

## COUNT I

### (PATENT INFRINGEMENT)

39. Katz Technology Licensing realleges and incorporates by reference paragraphs 1-38 of this Complaint as if fully set forth herein.

40. Katz Technology Licensing is the sole holder of the entire right, title, and interest in the ‘968, ‘150, ‘404, ‘984, ‘285, ‘707, ‘863, ‘551, ‘734, ‘762, ‘893, ‘120, ‘065, ‘965, ‘134, ‘703, ‘223, ‘415 and ‘360 Patents.

41. Upon information and belief, the EchoStar defendants operate automated telephone systems, including without limitation the DISH Network customer service telephone system, that allow their customers to perform pay-per-view ordering and customer service functions over the telephone.

1           42.     The EchoStar defendants have directly and contributorily infringed, and induced  
2 others to infringe, one or more claims of each of the patents identified in paragraph 40 of this  
3 Complaint by making, using, offering to sell, and/or selling within the United States automated  
4 telephone systems, including without limitation the DISH Network customer service telephone  
5 system, that allow their customers to perform pay-per-view ordering and customer service  
6 functions over the telephone.

7           43.     The EchoStar defendants continue to infringe, contributorily infringe, and induce  
8 others to infringe the '984, '734 and '120 Patents.

9           44.     The EchoStar defendants' infringement of the patents identified in paragraph 40 of  
10 this Complaint has been willful.

11           45.     Katz Technology Licensing has been, and continues to be, damaged and  
12 irreparably harmed by the EchoStar defendants' infringement, which will continue unless the  
13 EchoStar defendants are enjoined by this Court.

14                               **REQUEST FOR RELIEF**

15           WHEREFORE, Plaintiff Katz Technology Licensing respectfully requests the following  
16 relief:

17           A.     A judgment holding the EchoStar defendants liable for infringement of the patents  
18 identified in paragraph 40 of this Complaint;

19           B.     A permanent injunction against the EchoStar defendants, their officers, agents,  
20 servants, employees, attorneys, parent and subsidiary corporations, assigns and successors in  
21 interest, and those persons in active concert or participation with them, enjoining them from  
22 continued acts of infringement of the '984, '734 and '120 Patents;

23           C.     An accounting for damages resulting from the EchoStar defendants' infringement  
24 of the patents identified in paragraph 40 of this Complaint, together with pre-judgment and post-  
25 judgment interest;

26           D.     A judgment holding that the EchoStar defendants' infringement of the patents  
27 identified in paragraph 40 of this Complaint is willful, and a trebling of damages pursuant to 35  
28 U.S.C. § 284;